REMARKS

In response to the Office action dated July 20, 2005, Applicants respectfully request reconsideration and withdrawal of the rejections of the claims.

Claims 74-80 were rejected under 35 U.S.C. § 101, as allegedly being directed to non-statutory subject matter. The Office Action identifies a two-prong test, namely "whether the invention is within the technological arts," and "whether the invention produces a useful, concrete and tangible result." It is respectfully submitted that the first prong of this test, namely the requirement for "technological arts," is not appropriate, in view of the recent decision of the Patent Office Board of Appeals and Interferences in *Ex parte Lundgren*, Appeal No. 2003-2088, Application No. 08/093,516 (BPAI September 2005).

Furthermore, with respect to the second stated prong of the test, it is respectfully submitted that the claimed subject matter produces a useful, concrete and tangible result. Specifically, the claimed outcome of the invention is the generation and returning of a custom store page that provides customers with a restricted set of products and/or non-standard pricing for those products, in response to a request that originated from a predetermined host. The generation and transmission of such a page is not merely an abstract idea, law of nature, or natural phenomenon. Rather, it is the mechanism via which customers can purchase products that have been specially selected and/or priced for them.

Accordingly, it is respectfully submitted that the claims, as presented, recite statutory subject matter. Nevertheless, to advance the prosecution and remove any question on this issue, claim 74 has been amended to explicitly recite that the database is contained within a computer system, and that the administrative and

custom store applications execute on a computer. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 74-80 were rejected under second paragraph of 35 U.S.C. §112. With respect to claim 74, the Office Action states that the term "and/or" is indefinite. It is respectfully submitted that a person of ordinary skill in the art understands this term to mean either or both of the recited elements are present. To advance prosecution, however, the term has been removed from the claim.

The Office Action also identifies the term "dynamically" in claim 74 as being indefinite. Again, it is respectfully submitted that a person of ordinary skill in the art understands this term to designate an action that occurs in response to a particular condition. In the present case, claim 74 recites that the custom store application is responsive to a request for access to dynamically generate a custom store page. Again, to remove the issue and advance prosecution, the word " dynamically" has been removed from the claim.

In connection with claims 74 and 78, the Office Action alleges that the term "predetermined" renders the claim indefinite, because it "appears to refer to activities that take place outside the metes and bounds of the claim." The basis for this statement is not understood. The word "predetermined" is not referring to an activity, per se. Rather, it functions as a qualifier on the source of requests that can cause the custom store to be generated and returned to the requestor. Specifically, a request from any host on the Internet does not cause the custom store to be generated and returned. Rather, only requests from a predetermined host, i.e. one that is known a priori, will cause the custom store to be generated and returned.

Thus, the term does not refer to an activity outside the metes and bounds of the claim. Rather, it is a limitation of the claimed subject matter itself.

A search of the Patent Office website reveals that over 55,000 patents have issued since 1976 with the word "predetermined" in their claims. It seems inconceivable that so many patents would have issued with this term if it was considered to be indefinite.

The Office Action states that the Examiner interprets the term "predetermined host" to refer to "a portion of URL information that is used by the system to recognize a *customer* as being in a particular *customer group* based upon the link used to access an online store." (emphasis added) It is respectfully submitted that there is no basis for this interpretation. As stated above, in claim 74 the term "predetermined" is a qualifier on the type of *host*, i.e. a machine. It does not pertain to the identification of customers, namely the particular person who is sending a request from the machine. Rather, it is concerned with the machine itself from which the request orginates.

It is respectfully submitted that the term "predetermined host" appearing in claim 74 is definite and should be interpreted in accordance with the ordinary and custom meaning of those terms, namely a machine that is known a priori.

In response to the objection to the term "obsolete" in claim 76, this claim has been amended to more explicitly state the commonly understood meaning of the term.

With respect to claim 77, the Office Action alleges that the term "automatically" renders the claim indefinite. Again, it is respectfully submitted that

this is a term whose meaning is readily understood to connote an action that a machine carries out on its own, without requiring manual intervention.

With respect to claim 80, the Office Action states that the term "identification" is indefinite because "previous claims refer to '... determination...' " This statement is not understood. Claim 80 depends from 79, which recites that the request for access "includes an identification of the custom store to be selected." Claim 80 recites that this "identification" is contained in a referrer head field of the request. It is respectfully submitted that the subject matter to which claim 80 refers is clear and definite. If the rejection of this claim is not withdrawn, the Examiner is respectfully requested to explain the basis for the statement in the Office Action.

Claim 74 and 76-79 were rejected under 35 U.S.C. § 103, on the grounds that they were considered to be unpatentable over the Henson patent in view of the Blinn patent. Claims 75 and 80 were rejected on the basis of these two patents, in further view of the Fields patent. For at least the reasons presented in Applicants' previous response, it is respectfully submitted that these references do not suggest the claimed subject matter.

In particular, in their previous response, Applicants pointed out that the references do not disclose the concept of generating and returning a custom store page in dependence upon whether a request for access to an electronic commerce site originated from a *predetermined host*, e.g. a particular server. Rather, they disclose that access to a particular site is made available on the basis of the identification of the *user*.

In response, the Office Action refers to the Henson patent at column 14, lines 19-41. It is respectfully submitted that this portion of the patent does not disclose,

nor otherwise suggest, the claimed subject matter. Rather, it states that a *customer* is identified as being in a particular customer set according to what *link* the customer executed to get to the online store. The patent gives the example where a customer goes to an online store, e.g. www.dell.com, and the store offers the customer an option to go to a federal site. A link is embedded in the store page, that enables the customer to go to the federal site. It is respectfully submitted that the link that a customer uses to access a page does not identify whether a request for that page originated from a particular *host,* i.e. machine. Rather, as stated in the patent, it only identifies that fact that the customer "came and read the federal site page content," which identifies the customer as a federal customer. The patent does not disclose, nor otherwise suggest, that this activity is associated with a particular host. For at least this reason, therefore, the references do not suggest the subject matter of the pending claims.

In addition, other distinguishing features of the invention are recited in the dependent claims. For example, claim 76 recites a reconciliation application that determines whether configuration data includes information relating to products that have become obsolete, and provides notification to the administrator in such a case. The Office Action acknowledges that the Henson patent does not disclose such a feature. However, it goes on to refer to the disclosure at column 7, line 57 through column 8, line 6. This portion of the patent relates to the compatibility of various options in a configuration being built by a *customer.* It is nothing to do with configuration data that is stored in a database to define products that are to be made available to the customers. Nor does it have anything to do with the state of

obsolescence of such products. As such, the Henson patent cannot be interpreted to suggest the subject matter of claim 76.

Claim 78 recites that the database stores configuration data for a plurality of different custom stores, and the configuration data for a particular store is selected on the basis of the predetermined host from which the request for access originated. In rejecting this claim, the Office Action refers to the Henson patent at column 14, lines 4-18. It is respectfully submitted that this portion of the patent does not suggest the claimed subject matter. Rather, it discloses that a custom store "specific to the given customer" is selected. Thus, consistent with the discussion presented above, the system of the Henson patent operates on the basis of the identification of the *customer*, not on the basis of the host from which requests originate.

For at least these same reasons, the Henson patent does not suggest the subject matter of claims 79 and 80.

In view of the foregoing, it is respectfully submitted that all pending claims meet the requirements of the statute, and are patentably distinct from the cited references.

Reconsideration and withdrawal of the rejections, and allowance of all claims are respectfully requested.

Respectfully submitted,

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